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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,085	01/13/2000	HIDEO ANDO	0039-7513-2S	6528

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 04/23/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/482,085

Applicant(s)

ANDO ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24 and 32-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 and 32-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 24 , 32 and 35-36, 38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiroshima et al (5,801,781) .

Regarding claims 24 and 35-36, 38 and 40, Hiroshima discloses a information storage medium, comprising:

a data area (payload area) configured to store an MPEG transport stream (Fig. 4, 11) containing information of I pictures (column 9, lines 1-7), the MPEG transport stream being recorded as data units (Fig.3); and a management area (header area) configured to store support information contained in the MPEG transport stream, wherein,

the support information to be stored in said management area is configured to include at least one of a first information indicating the data unit which contains an access unit corresponding to an I-picture, and a second information of a random access indicator corresponding to the I-picture since the random access indicator indicating a start of a

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sequence and I picture is a picture start of sequence In according to MPEG stream format.

Further for claim 35 and 40, Hiroshima further teaches recording support information and transport stream (Fig. 3)

Further for claims 36 and 38, Hiroshima teaches the reading units for reading the support information and transport stream (fig. 3).

Regarding claim 32, Hiroshima further teaches that the support information includes at least one of a group including:

a first support flag of the random access indicator indicating whether random access is permitted,

a second support flag of a unit start indicator, wherein data of the I-picture is configured to be read when said unit start indicator is supported,

a third support flag indicating whether a program association table and a program map table are supported, and

a fourth support flag indicating whether a presentation clock reference is supported (figs. 13,14).

3. Claims 24 and 35-36, 38 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al (6,470,135) .

Regarding claims 24, 35-36, 38 and 40 Kim discloses a information storage medium and apparatus for recording/ reproducing information on and from the recording medium (Fig. 1).The medium comprises:

a data area (230) configured to store an MPEG transport stream (column 3, lines 15-30, column 4, lines 50-55) containing information of I pictures said MPEG transport stream being recorded as data units; and a management area (260 or header in transport stream) configured to store support information contained in the MPEG transport stream, wherein,

the support information to be stored in said management area is configured to include at least one of a first information indicating the data unit which contains an access unit corresponding to an I-picture, and a second information of a random access indicator corresponding to the I-picture (column 4, lines 45-55, column 5-6, column 7, lines 40-55).

Further for claims 35 and 40, Kim teaches units or parts for recording the support information and transport stream on the medium (column 3).

Further for claims 36 and 38, Kl further teaches units r parts for reproducing the support information and transport stream (column 4, lines 45-55, column 5-6, column 7, lines 40-55)..

Regarding claim 41, Kim further teaches either of said first and second information serves to permit a special playback mode including a first forward or first reverse (column 5 lines 60-68).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (6,470,135) in view of Nijima et al (5,903,314).

Regarding claim 37., Kim discloses a method for recording a broadcasted MPEG transport stream in an information storage medium which comprises, a data area configured to store an MPEG transport stream containing information of I pictures (column 3, column 4, lines 50-55) said MPEG transport stream being recorded as data units, and a management area configured to store support information contained in the MPEG transport stream, wherein, said support information to be stored in said management area is configured to include at least one of a first information indicating the data unit which contains an access unit corresponding to an I-picture, and a second information of a random access indicator corresponding to the I-picture, said recording method comprising: obtaining electric program guide information from the broadcasted MPEG transport stream; designating a program to be recorded using said electric

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program guide information; obtaining the support information of the designated program from the broadcasted MPEG transport stream; writing the obtained support information in the management area of said medium; and recording information of the broadcasted MPEG transport stream of the designated program (column 4, lines 45-55, column 5-6, column 7, lines 40-55).

Kim fails to teaches using EPG for recording the a desired program .

Nijima teaches a method for receiving EPG frame a broadcast transport stream and using the EPG for selecting a program to be recorded by a recorder (column 16 lines 1-40). It would have been obvious to one of ordinary skill in the art to modify Kim with Nijima by using apparatus as taught by Nijima for receiving EPG from transport stream and using the received EPG to record a desired program thereby providing more convenience to the user in selecting a desired program to be recorded .

6. Claims 33,34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (6,470,135) in view of Kawakami e al (5,991,502).

Regarding claims 33 , 34 39 , Hiroshima fails to teaches the support information includes information relating to the I-pictures and the support information to is configured to have specific portions for including one or more address information of the I-pictures to be recorded in said data area and produce only I picture .

Kawakami teaches a recording apparatus having means for generating information relation to I picture of MPEG stream and storing the information in a management area (header) and using the support information to reproduce only I

pictures (Figs.2, column 8) . It would have been obvious to one of ordinary skill in the art to modify Hiroshima with Kawakami by providing the medium of Hiroshima with information relating to I pictures in order to easily identify the I pictures in the stream .

7. Claims 33, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (6,470,135) in view of Kawakami et al (5,91,502).

Regarding claims 33, 34, 39, Kim fails to teach the support information includes information relating to the I-pictures and the support information is configured to have specific portions for including one or more address information of the I-pictures to be recorded in said data area and produce only I picture .

Kawakami teaches a recording apparatus having means for generating information relating to I picture of MPEG stream and storing the information in a management area (header) and using the support information to produce only I pictures (Fig. 2, column 8). It would have been obvious to one of ordinary skill in the art to modify Hiroshima with Kawakami by providing the medium of Kim with information relating to I pictures in order to easily identify the I pictures in the stream .

### ***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER customer service the receptionist whose telephone number is (703) 306-0377.

H.N  
April 20, 2003

  
HUYNH NGUYEN  
PRIMARY EXAMINER